

REMARKS

Applicants have carefully reviewed this Application in light of the Final Office Action mailed December 8, 2008. Claims 27-42 are pending in this Application and Claims 27-42 stand rejected under 35 U.S.C. § 103(a). Claims 1-26 were previously canceled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 27-33 and 39-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over International Application No. WO9833343 issued to Marja-Leena Lehmus et al. ("*Lehmus*") in view of U.S. Patent 6,907,239 issued to Timo E. Sivula ("*Sivula*").

Claims 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehmus* in view of *Sivula* and further in view of U.S. Patent 6,967,011 issued to Arnaud Capitant ("*Capitant*").

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S. Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog*

Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S. Ct. at 1741.

The Examiner's response to Applicants' previous argument is unclear. In the Response to Arguments section, Examiner states that "Lehmus clearly reads on the argued limitation of 'communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result.'" (See Office Action at 3–4.) Later in the Office Action, however, Examiner states that "Lehmus does not specifically teach communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result." (See Office Action at 5–6.) Thus, Examiner appears to have taken contradictory positions with respect to the teaching of *Lehmus*, and it is unclear to what extent, if at all, Examiner relies on *Lehmus* as teaching the elements of the cited limitation.

Further, according to 37 C.F.R. § 1.104(c)(2) the Examiner must clearly explain the pertinence of each reference with respect to each rejected claim. Applicants respectfully submit that the Examiner failed to explain the pertinence of *Lehmus* with respect the limitation of "communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result" recited in claim 27. Specifically, Examiner stated:

Examiner has actually argued that *Lehmus* in combination with *Sivula* teaches a transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device. The combination teaches a SIM card receiving a message containing information about a sum to be debited. The application in the SIM device requires approval of the debiting message by the user before the message is forwarded to a server that verifies creditworthiness. Therefore, the combination clearly reads on "a transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device".

(Office Action, page 4.) It is unclear to what extent Examiner relies on *Lehmus* as teaching the elements of the cited limitation, and to what extent Examiner relies on *Sivula* as teaching the elements of the cited limitation.

Nevertheless, Applicants have previously argued that *Sivula* fails to teach a transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device:

The Examiner stated that *Siluva* clearly teaches communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device. (Office Action, page 3, first full paragraph). Applicant respectfully disagrees. The user identification device in *Siluva* is the Subscriber Identification module (SIM). (*Siluva*, col. 1, lines 52-55). However, contrary to the Examiner's assumption, no transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device takes place. Rather, *Siluva* teaches a different approach. According to *Siluva*, to establish a pre-paid service, a user must create an account. This is done by buying a SIM card. (*Siluva*, col. 1, lines 52-55) The user must then call an automatic answering device and provide the automatic answering device with the serial number to establish the account. (*Siluva*, col. 1, lines 56-61) Hence, according to *Siluva* up to this point the SIM card is not even physically involved because the user has to communicate the serial number to the answering machine. *Siluva* leaves it open how the actual debiting of the account is accomplished by merely stating that the account will be debited when telephone calls are made and short messages are sent. (*Siluva*, col. 1, lines 60-61) Nowhere is stated that the SIM card actually receives a pre-paid account status message let alone that this pre-paid account status is evaluated and communicated from the SIM card to the telephone. Rather, *Siluva* teaches that the user must refill the account when the remaining value on the account approaches zero by buying a ticket and calling to a dedicated telephone number. (*Siluva*, col. 1, lines 61-65) Thus again, the SIM card is not involved in this transaction as this transaction is clearly performed manually by a user.

(9/16/2008 Response to Office Action, page 7.) Applicants respectfully submit that Examiner has failed to answer the substance of Applicants' traversal as required by MPEP § 707.07(f). Thus, Applicants submit that *Sivula* does not disclose the above recited limitation as explained in the quote above.

To the extent Examiner relies on *Lehmus* as teaching this limitation, Applicants respectfully disagree. In *Lehmus*, the system J1 is the telecommunication device. (*Lehmus*, Fig. 3.) *Lehmus* explicitly states that to establish a pre-paid service, money is pre-loaded onto the SIM module. (*Lehmus*, page 10, lines 21-23.) *Lehmus* teaches that after money is pre-loaded onto the SIM module, "The procedure continues by first reading into the subscriber identity module SIM the sum to be debited, block 32, and then debiting the customer by decreasing (block 33) his/her payment tickets created beforehand on the card SIM." (*Lehmus*, page 10, lines 23-27.) Importantly, *Lehmus* states that with a pre-paid card, "no debiting will have to be done from the server 10." (*Lehmus*, page 10, lines 20-21 (emphasis

added).) Thus, it is impossible that the SIM card in *Lehmus* would receive a pre-paid account status message from the server since the SIM module does not communicate with the server when using a pre-paid card. Because of this, the SIM module has no pre-paid account status to evaluate and/or communicate to the telecommunication device (system J1).

Hence, both *Sivula* and *Lehmus* clearly lack any disclosure of the above recited limitation. Therefore, the combination of *Lehmus* and *Sivula* cannot render the present independent claim 27 obvious. Independent claim 39 includes similar limitations and therefore should be allowable as well. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. § 103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

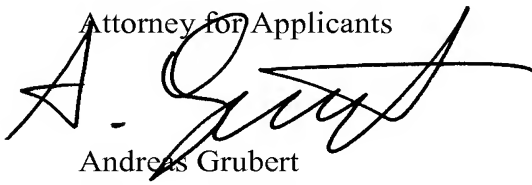
CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of all pending Claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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